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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/538,786

06/14/2005

Migaku Suzuki

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OLIFF & BERRIDGE, PLC

P.O. BOX 320850

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EXAMINER

REICHLE, KARIN M

ART UNIT

PAPER NUMBER

3761

NOTIFICATION DATE

DELIVERY MODE

09/15/2010

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

OfficeAction25944@oliff.com

jarmstrong@oliff.com

<b>Office Action Summary</b>	<b>Application No.</b> 10/538,786	<b>Applicant(s)</b> SUZUKI ET AL.
	<b>Examiner</b> Karin M. Reichle	<b>Art Unit</b> 3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 2-6 and 8-40 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-6 and 8-40 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 June 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                    | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 7-19-10 has been entered.

### ***Specification***

The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

For Example:

### ***Drawings***

2. The drawings are still objected to because Figures 30A-B should be labeled as "Prior Art". Also, descriptive text, e.g. "DISCHARGED LIQUID", should be avoided in the Figures. The Figures are not consistent with the description thereof as now amended, e.g. on pages 11-15. See also discussion *infra*, e.g. paragraphs 3 and 5. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing

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on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either “Replacement Sheet” or “New Sheet” pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the invention as claimed in claims, e.g. 40, 26 and 38, see also discussion *infra*, esp. paragraphs 5 and 10 *infra* and paragraph 2 of the last Office Action of 3-2010, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as “amended.” If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the

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drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Description***

4. 35 U.S.C. 112, first paragraph, requires the specification to be written in "full, clear, concise, and exact terms." The specification is replete with terms which are not clear, concise and exact. The specification should be revised carefully in order to comply with 35 U.S.C. 112, first paragraph. Examples of some unclear, inexact or verbose terms used in the specification are: the amendment to page 17, line 8, line 1 thereof is missing a number, page 2, fifth line from the bottom, the amendment to page 4, line 1, last two lines, page 20, second full paragraph, line 1 thereof, page 25, last full paragraph, and page 43, line 4. It is also noted that the reference to the inventors on pages 29, 31 and 42 should also be avoided.

5. The disclosure is objected to because of the following informalities: The description is replete with informalities. For example: 1) The Summary of the Invention section, i.e. a description of the invention of the claims, and the claims are still not commensurate, e.g. where is the invention of page 4, section 1 set forth in the claims? 2) The description of the Figures, e.g., on pages 11-15, page 43, first full paragraph, page 45, second full paragraph should be consistent with the Figures, e.g. where are Figures 7F-G, 11A-B and 14 described? 3) In the

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amended paragraph at page 4, line 1, the last line appears to be inaccurate, i.e. "absorber" should be --absorbent product--. Note 2) supra. 4) The description of the invention throughout the application is, at the very least, unclear/inconsistent/incomplete (note the discussion in, e.g., paragraphs 6 and 8-9 infra also). For example, where is a detailed description of Figures 7F and G now set forth? For another example, note page 18, first full paragraph, first sentence refers to the product having two absorbers but in the last sentence the product only refers to a/one absorber 14. This also applies to the description on page 24, last paragraph. For a third example, claim 40 now sets forth "a lamination direction in which the absorber and a surface sheet are laminated on the back sheet". At the very least, see discussion infra, where is the antecedent basis for such claim terminology? See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Claim 40 also claims *a set of flow passages are formed in the longitudinal direction beginning on the top of the surface sheet where a discharged liquid is supplied from the wearer's body, each flow passage exceeding each lateral end of the surface sheet and extending along a space between the left and right walls of the back sheet and the left and right sides of the absorber respectively, and each flow passage is provided such that at least a part of a discharged liquid flows off from the surface sheet into at least one of the flow passage*, toward the back sheet and moves between the back sheet and the absorber. Yet Figures 1A-B and Figures 5A-B as well as page 16, last full paragraph, page 20, first full paragraph, page 21, second full paragraph, and page 22, first full paragraph describe flow passages which are formed in the longitudinal direction which exceed the longitudinal edges (ends?) of the surface sheet and/or flow passages which are formed in the lateral direction which exceed the lateral edges (ends?) of the surface sheet so that liquid flows off from the surface sheet, i.e. the flow passages, into spaces between the backsheet and

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absorber. It is noted that page 22 also sets forth that there is no limit to the shape, direction etc. of grooves in the surface sheet, and page 16, first full paragraph, page 20, first full paragraph, and page 21, second full paragraph set forth that the flow passages are formed by such shaped portions of the surface sheet and the spaces between the sides of the backsheet and absorber. Therefore it is unclear from such descriptions of the flow passages the shape/direction of the flow passages, e.g. the flow passage(s) of the surface sheet, e.g., as claimed extend longitudinally or laterally or both along their entirety, i.e. diagonals, both along a portion, i.e. curved?, as well as their extent with regard to the structures of the invention, i.e. are the flow passages formed on top of the surface sheet and the spaces, see, e.g., second to last paragraph of claim 40, or by the spaces/porions of a flow passages between the backsheet and absorber, see, e.g., the last paragraph of claim 40. Note also claim 2, claim 5, claim 10, claim 35, and the discussion infra. For a final example, the description of the various sheets in claims 26, 38, 27 and 39 and, e.g., page 45, first full paragraph, Figures 15A-B, 18A-18C, page 48, line 3-page 52, line 3 of the application are also unclear/inconsistent, see, e.g. the discussion in paragraph 8 infra. Note also discussion of Figure 15B in, e.g., paragraph 2 of the last Office action. At the very least, see discussion infra, a clear consistent description throughout the application should be set forth. The entire description should be carefully reviewed and revised, as necessary. Applicant is thanked in advance for his/her cooperation in placing the description in proper form.

Appropriate correction is required.

6. The amendment filed 1-2-09 is still objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The amendments which are not

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supported by the original disclosure is as follows: the amendments to pages 12, 26, 27, 28, 34, 35 and 39.

Applicant is required to cancel the new matter in the reply to this Office Action.

Where is the invention, i.e. a description of the same scope, e.g. the description of portions 20/absorbent product of Figures 7F-G, the combinations of the relationships of 6A-6F and 7F-G, as originally filed, still described? Note again MPEP 2163.02, second to last paragraph.

### *Claim Objections*

7. Claims 2-6 and 8-40 are objected to because of the following informalities: For example, in claim 40, line 12, “each of” should be deleted and on line 13, after “absorber”, --, respectively,-- should be inserted. Lines 14-15 could be rewritten as --extending to define a height perpendicular to both the lateral and longitudinal directions which is greater than a height also perpendicular to both the lateral and longitudinal directions from the back sheet covering the lower surface of the absorber to a top surface of the surface sheet--. Note also line 17 and the discussion in paragraph 8. On line 16, “are” should be deleted. On line 21, “of a” should be --of the-- and on line 22, “passage” should be --passages--. Note however the discussion in paragraph 8. Claim 2, i.e. “on both right and left sides of the absorber”, is now redundant. See also discussion in paragraph 8. In claim 3, “single-layer” should be --single layer--. In claim 16, “two layers or more” should be --at least two layers-- and “one layer or more than one layer” should be --at least one layer--. In claim 19, “in-between” should be --in between--. Appropriate correction is required.



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7a. Applicant is advised that should claim 38, which depends from claim 8, be found allowable, claim 27, which depends from claim 38, will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k). See discussion of such claims in paragraph 8.

### ***Claim Rejections - 35 USC § 112***

8. Claims 2-6 and 8-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In regard to claim 40, a positive structural antecedent basis for “the top...body”, lines 16-17, should be set forth. Also, the description of the flow passages on lines 16-20, i.e. “each flow passage exceeding each lateral end...and extending along a space”, and that on lines 21-22, i.e. “each flow passage is provided such that liquid flows off from the surface sheet into at least one of the flow passage [sic]”, appears to be inconsistent/unclear, i.e. are the set of flow passages formed on the surface sheet and continued along a space **or** only so as to receive discharged liquid from the surface sheet? See also discussion supra and infra. In regard to claim 2, it is unclear whether Applicant is claiming the at least one of the flow passages in the absorber (Note such is not claimed as being between the backsheet and absorber, i.e. in such case, “also” should be set forth on line 2 before “provided”) or provided in a surface sheet covering such portions of the absorber and/or something else, e.g., by spaces formed between sides of backsheet and

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absorber? In the latter case, such, i.e. “on both right and left sides of the absorber and/or”, would appear to be inconsistent with lines 16-20 of claim 40. In regard to claim 4, a positive structural antecedent basis for “the upper side of the...film” should be set forth. In regard to claim 35, a positive structural antecedent basis for “the flow passage” (Note more than one flow passage has been claimed) should be set forth. In regard to claims 8 and 37, a positive structural antecedent basis for “the surface of the upper side of the surface sheet”, see discussion in paragraph 7 and of claim 40, lines 16-17 supra. In regard to claim 9, a positive structural antecedent basis for “the lateral sides” should be set forth. Also, are such sides and the right and left sides as claimed in claim 40 one and the same, i.e. at a minimum how many sides is claim 9 requiring? Claim 9 appears to be inconsistent with claim 40, i.e. if the guide sheet covers all of the lateral sides of the absorber over the surface sheet, then the surface sheet covers the lateral sides, i.e. flow passages would not exceed surface sheet and extend along space as claimed as best understood. In regard to claim 10, this claim also appears to be inconsistent with claim 40, i.e. dependent on the location of the flow passages, e.g. lines 16-20 of claim 40 claim flow passages which are more than on top of the surface sheet whereas lines 21-23 claim flow passages which are not on the surface sheet, see also discussion thereof supra. In regard to claims 36 and 39, a positive structural antecedent basis for “the surface of the upper side of the surface sheet or the guide sheet” should be set forth. In regard to claim 37, the last two lines appear to be inconsistent with claim 8, i.e. if the guide sheet is laminated to the surface sheet how can the unit include at a minimum only the surface sheet and absorber as claimed? Similarly claims 23, 26 and 38, e.g. “is included in at least a portion”, appears to be inconsistent/inaccurate, i.e. wouldn’t the sheet laminated to the surface sheet or surface sheet of

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the absorber received by the housing include all of the sheet in a portion between the space and the housing, which housing continues to the space? In regard to claim 11, a positive structural antecedent basis for “the upper side of the surface sheet” should be set forth. In regard to claim 14, a positive structural antecedent basis for “the surface of the lower side of the ...film” should be set forth. Claim 25 and 29 are unclear, i.e. at a minimum, are the units laminated to each other and/or within each unit?

9. Claims 2-6 and 8-40 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. See discussion in paragraph 7 supra and esp. MPEP 2163.02 cited therein. Also, new claim 40 now claims *a set of flow passages* are **formed in the longitudinal direction beginning on the top** of the surface sheet where a discharged liquid is supplied from the wearer's body, **each flow passage** exceeding **each lateral end of the surface sheet and** extending along a space **between the left and right walls** of the back sheet and **the left and right sides of the absorber** respectively, and **each** flow passage is provided such that at least a part of a discharged liquid **flows off from the surface sheet into** *at least one of the flow passage*, toward the back sheet and moves between the back sheet and the absorber. While, e.g., Figures 1A-B and Figures 5A-B as well as page 16, last full paragraph, page 20, first full paragraph, page 21, second full paragraph, and page 22, first full paragraph describe flow passages which are formed in the longitudinal direction which exceed the longitudinal edges (ends?) of the surface sheet and/or flow passages which are formed in the lateral direction which exceed the lateral edges (ends?) of

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the surface sheet so that liquid flows off from the surface sheet into spaces, i.e. continuation of the flow passages between the backsheet and absorber and page 22 also sets forth that there is no limit to the shape, direction etc. of grooves in the surface sheet, and page 16, first full paragraph, page 20, first full paragraph, and page 21, second full paragraph set forth that the flow passages are formed by such shaped portions of the surface sheet and the spaces between the sides of the backsheet and absorber, as best understood, see discussion supra in paragraph 5, and at the very most, see again the discussion in paragraph 5, this is not what is claimed. Applicant did not point out the specific portion of the specification relied upon for support, see MPEP 714.02, second to last paragraph. The lack of apparent support is also further exacerbated by the lack of clarity, see paragraphs 5 and 8. Note also claim 2, claim 5, claim 10, claim 35 and the discussion supra. If Applicant maintains such claim language, the specific portion of the application as originally filed which provides support commensurate in scope in a single embodiment for the combination of each claim should be set forth.

### ***Claim Language Interpretation***

10. With regard to claim 40 and thereby the claims which depend therefrom, claim 40 is interpreted to require an absorbent product structured as claimed on lines 1-12, as well the left wall and the right wall extending along a left side and a right side of the absorber, respectively, and extending to define a height perpendicular to both the lateral and longitudinal directions which is greater than a height also perpendicular to both the lateral and longitudinal directions from the back sheet covering the lower surface of the absorber to a top surface of the surface sheet, a set of flow passages formed in the longitudinal direction, i.e. at least a portion of each

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flow passage extend longitudinally, beginning on a top side of the surface sheet where a discharged liquid is supplied from the wearer's body, each flow passage also exceeding each lateral edge of the surface sheet, i.e. at least a portion of each flow passage extends to each lateral edge, and extending/continuing along a space between the left and right walls of the back sheet and the left and right sides of the absorber respectively, yet, as best understood, each flow passage also provided such that at least a part of the discharged liquid flows off *from the surface sheet* **into at least one of the flow passage**, toward the back sheet and moves between the back sheet and the absorber. It is noted, however, that “the discharged liquid” is not required to be/include all liquid discharged to the product. In claim 20, the terminology “means” on line 3 is interpreted not to invoke 35 USC 112, sixth paragraph. Claim 20 is still also a product by process claim, see MPEP 2113, i.e. “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process. In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966.” The end product of claim 20 is considered to be a liquid-permeable non-woven fabric with a coat of super absorbent polymer. “Coat” is defined by the dictionary as “a layer of one substance covering another” (emphasis added).

### ***Response to Arguments***

11. Applicant's remarks have been carefully considered but are deemed either moot in that the issue discussed has not been reraised or deemed not persuasive for the reasons set forth

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supra. Specifically, while as best understood the prior art does not teach the features of the last three paragraphs of claim 40 in combination with the structure and function of the remainder of the claim, see paragraph 10 supra, see also the discussion in paragraphs 5-9 supra. Applicant's remarks on page 10, second paragraph are noted. See the Interview summary Form as to what was agreed to. With regard to page 11, third full paragraph, Applicants remarks are narrower than the evidence of record, what "intrinsic evidence"?

### ***Conclusion***

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karin M. Reichle whose telephone number is (571) 272-4936. The examiner can normally be reached on Monday-Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tanya Zalukaeva can be reached on (571) 272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Karin M. Reichle/

Primary Examiner, Art Unit 3761

September 8, 2010